

REMARKS

The Examiner is respectfully requested to enter the foregoing amendment prior to examination of the above-identified patent application. By the Amendment above, the specification and claims 6 and 9 are amended. New claims 15-18 are added. No new matter is presented. Support for new claims 15-18 can be found on at least page 15, lines 12-15 of the specification. Support for the amendments to claims 6 and 9 can be found on at least page 13, line 12 to page 15, line 15, page 4, line 27 to page 5, line 3 of the specification and Figs. 8a and 8b as originally filed.

Claims 1, 2 and 5-18 are pending. Claims 1, 2, 5 and 12-14 have been allowed. Claims 6-11 and 15-18 are respectfully submitted for consideration.

Allowable Subject Matter

The Applicants wish to thank the Examiner for allowing claims 1, 2, 5 and 12-14.

Interview

The Applicants also wish to thank the Examiner for the interview granted on March 1, 2006. In the interview, the claims and the rejections under 35 U.S.C. § 112, first and second paragraphs were discussed. Also, the Komaki et al. reference was discussed (U.S. Patent No. 5,185,730, "Komaki"). The Examiner requested clarification on the "influence of the prepit" feature recited by amended claims 6 and 9. The Applicants have added new claims 15-18 based on the comments of the Examiner and amended claims 6 and 9 to clarify this feature.

In the interview, the Examiner also requested further information on the signal that is output through the subtractors 64 and 65. The Applicants respectfully submit that

the output signal via the subtractor 64 is a prepit signal, while the output signal via the subtractor is a noise component from the prepit to the tracking signal.

Rejections Under 35 U.S.C. 112

Claims 6-11 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 6-11 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 7 and 8 depend from amended claim 6 and claims 10 and 11 depend from amended claim 9.

With respect to the § 112, first paragraph, rejection, the Office Action stated that the specification as originally filed did not provide support for the limitation of removing the influence of the prepit based on the tracking signal as claimed. This limitation has been deleted from the claims and the removal of the influence of the prepit has been clarified in amended claims 6 and 9.

With respect to the § 112, second paragraph, rejection, the Office Action stated that the drawings did not show removing the influence of the prepit as claimed. As discussed above with respect to the § 112, first paragraph rejection, the applicants have amended claims 6 and 9 to clarify the removal of the influence of the prepit.

As the Applicants have amended claims 6 and 9 responsive to the rejections, the Applicants respectfully submit that all claims are in compliance with U.S. patent practice.

Rejection Under 35 U.S.C. 102

Claims 6, 7, 9 and 10 were rejected under 35 U.S.C. § 102(b) as being anticipated by Komaki. The Applicants respectfully submit that claims 6, 7, 9 and 10 recite subject matter that is neither disclosed nor suggested by Komaki.

Komaki discloses a method for writing data to, and reading data from, an optical disk that has address information written on its land between grooves or in its pregrooves.

With respect to claims 6 and 9, the Applicants submit that Komaki does not disclose or suggest the claimed features of the invention. Claim 6, as amended, recites removing means for removing the influence of the prepit information from the preliminary tracking error signal and outputting an original tracking error signal. Claim 9, as amended, recites a removing circuit which removes the influence of the prepit information from the preliminary tracking error signal and outputs an original tracking error signal.

In contrast, Komaki discloses that the address information acquired by the address reading circuit 8 is given to the controller 9, the purpose of which is not to remove the influence of the prepit information included in the tracking error information, but to search the designated address. See Fig. 4, and column 3, lines 20-30 of Komaki. Specifically, when reproducing data corresponding to the desired address, the disc reproducing apparatus of Komaki identifies the place where the desired address information is acquired after tracking a beam on the land, and then generates kick pulses by the kick pulse generation circuit, and so jumps to pregrooves adjacent to the land having the desired address. See column 3, lines 31-41 of Komaki.

In Komaki, when applying the kick pulse, the loop switch 15 is held in an open state so as not to actuate tracking. Thus, the apparatus of Komaki applies the kick pulse under the condition that the tracking error signal transferred from the photoelectric conversion device 2 is blocked when the loop switch 15 is open. See column 3, line 31-34 and 38-39 of Komaki. As such, Komaki does not disclose or suggest at least the feature of removing the influence of the prepit information from a tracking error signal.

Therefore, the Applicants respectfully submit that Komaki does not disclose or suggest at least the combination of features of removing means for removing the influence of the prepit information from the preliminary tracking error signal and outputting an original tracking error signal, as recited in amended claim 6; or a removing circuit which removes the influence of the prepit information from the preliminary tracking error signal and outputs an original tracking error signal, as recited in amended claim 9.

According to U.S. patent practice, a reference must teach every element of a claim in order to properly anticipate the claim under 35 U.S.C. §102. In addition, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628,631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “Every element of the claimed invention must be arranged as in the claim. . . the identical invention, specifically, [t]he identical invention must be shown in as complete detail as contained in the claim.” Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989) (emphasis added). Accordingly, Komaki does not disclose or suggest the features of the invention as recited in amended claims 6 and 9. As such,

the Applicants respectfully submit that claims 6 and 9 are allowable. Claims 7 and 10 depend from claims 6 and 9, respectively and are allowable for at least the same reasons.

New independent claims 17 and 18 are based on claims 6 and 9, respectively, and are allowable distinguishable over Komaki for at least the same reasons discussed above, with respect to claims 6 and 9.

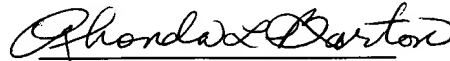
Conclusion

Claims 1, 2, 5 and 12-14 are allowed. Claims 7, 8 and 15 depend from amended claim 6 and claims 10, 11 and 16 depend from amended claim 9. The Applicants respectfully submit that each of these claims incorporate the patentable aspects thereof, and are therefore allowable for at least the same reasons as discussed above. Accordingly, the Applicants respectfully request allowance of claims 6-11 and 15-18 and the prompt issuance of a Notice of Allowability.

Timely examination on the merits is respectfully requested.

The Commissioner is authorized to charge payment for any additional fees which may be required with respect to this paper to our Deposit Account No. 01-2300, referencing Attorney Dkt. No. 107156-00033.

Respectfully submitted,



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RLB/wbp

Enclosures: Petition for Extension of Time (Three months)
Request for Continued Examination
Amendment and Fee Transmittal